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10/776,345	02/12/2004	Kyung-geun Lee	1793.1182	1717
49455 7590 03/17/2008 STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005				
EXAMINER				
PSITOS, ARISTOTELIS M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/776,345

Applicant(s)

LEE, KYUNG-GEUN

Examiner

Aristotelis M. Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/1/08 & 8/30/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's responses of 2/1/08 and 8/30/07 have been considered with the following results.

Errata

The submission of the TD with respect to US patent 7,009,926 has been entered and approved.

Due to the discovery during the search-up date of the listed pending US applications/patents the following rejections are introduced. Applicants' cooperation in providing any additional information with respect to any other pending applications which bear upon the presently claimed invention is respectfully requested so that no further delay in the prosecution of this pending application occurs.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claim 1-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/776343, further in view of the obvious modification of the claimed format, i.e., the copending application (parent) is drawn to method claims, while the present application claims are drawn to product claims. The examiner concludes that it is obvious the end result of the copending method claims is/are product claims of the nature presented herein. This is a provisional double patenting rejection since the conflicting claims have not yet

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been patented. Comparison of the claims in 10/776343 is with respect to the claims as presented on 10/9/07.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on the copending application as analyzed below:

Present application Sn 10/776343

claim 1 claim 1

Although the present claims are drawn to product claims, as opposed to the recording/reproducing method of the parent application, such is considered merely an obvious modification, i.e., obviously a product (products) is the end result of either the recording method, or alternatively, a product of the type presented herein is present in order for the reproducing method to perform/operate.

Claims 2-17 claims 2-17

Present claims are drawn to product limitations. These limitations are provided for in copending dependent claims 2-17. Obviously, either the product reproduced from the reproducing steps, or recorded to in the recording steps have the same limitations. It is noted that although present claims 9 and 11 have been re-written in independent form, they conform to copending claims 9/1 and 11/1.

Claim 18 Claim 18

Present claim are drawn to product limitations while the copending claims are drawn to step/method limitations. Obviously a product is the end result of the recording steps, or alternatively a product is present during the reproducing steps. The limitations find full correspondence in the copending claims.

Claims 19-23 claims 19-23

The claimed subject matter contained in these claims is obvious, i.e., the present product limitations/claims are obvious variants of the method claims.

Claim 24 Claim 24

Similar analysis of claims 24, i.e., along the same lines as claim 1 and 18 above, product limitations versus method limitations.

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Claims 25-32

claims 25-32

Product claims

vs.

method claims

Product limitations are obvious variants of the method claims, i.e., either a product is present during the reproducing method, or else a product is the end result of the recording method.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Claim 1-32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 11/430868 further in view of an obvious modification of the claimed format, i.e., the copending application (parent) is drawn to apparatus claims, while the present application claims are drawn to product claims. The examiner concludes that it is obvious in the copending apparatus claims is/are there must be a product used with the recording apparatus, i.e., an end result of the apparatus claims is a product claim(s) of the nature presented herein. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

In the present application, independent claim 9 corresponds to the limitations of copending claim 9/1 and independent claim 11 corresponds to the limitations of copending claim 11/1. Independent claims 18 and 24 correspond to the limitations of copending claims 18 and 24.

The dependent claims are self-evident.

Again, a product is the obvious end result of the copending apparatus claims; no further analysis with respect to these claims is made.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 1, 4-9, 12 and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No 6934236. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Present claims are drawn to product limitations while the above noted patent has claims drawn to method limitations. The apparatus limitations are obvious variants of the method limitations.

Furthermore,

a) the structural difference in the present independent claim 1, i.e., the lead-in, lead-out and user data areas are inherently present in the above claims of the patent – see for instance claim 6 or 7, and the writing pattern is interpreted a limitation included in claim 3 of the patent/ i.e., the recording pattern.

With respect to compending claims 12 and 17, see the disclosure with respect to description of the lead-in area having the particular zones – as well as MPEP §804 II B (1), as found on page 800-22, relying upon the disclosure as a dictionary.

With respect to claims 4 and 7, see patented claims 7 and 8.

With respect to claim 5, see patented claim 9.

With respect to claims 6 and 8, see patented claim 4 (push-pull is the difference).

With respect to claim 9, see patented claims 10 or 12.

The version number is the compatibility information.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1, 24 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Ko ('054), ('493) or ('605) as analyzed below each further considered with Tasaka et al.

The applied references have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Claims 1 and 24 are drawn to a product (an information storage medium), wherein compatibility information is provided for, and is USED to record.

Any of the above noted Ko patents disclose – see the abstracts thereof – the ability of having compatibility information – newer version – contained in/on a recording medium so as to make the drive compatible to newer versions. See the discussion with respect to figures 4 and 5 of the above documents.

Ko patent ('054) and ('605) are drawn to methods, while Ko ('493) is drawn to an apparatus.

Although there is no clear depiction of the lead-in, lead-out and user data area, the systems operate upon appropriately manufactured dvd discs and such physical areas, lead-in, lead-out and user data are inherently present.

If applicant can convince the examiner that such limitations are not inherently present, then under 103 considerations, the examiner relies upon the acknowledged prior art in this application that defines such.

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Although it isn't specified that the record medium also stores information about an optimal writing pattern, as noted/taught in Tasaka et al, the information as designated in figure 3 with respect to either the recording speed/or the opc as indicative of the optimal writing pattern.

It would have been obvious to modify the base system of Ko with such well-known record media, motivation is to use existing media in the above Ko systems and hence not require the manufacturing of non-standard discs along with such well known lead-in formatted discs.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of see Sasa et al ('595) starting at col. 8 line 39 with respect to the DVD Specification, July version 1.9. The examiner does not have a copy thereof. If applicant has a copy handy, submission of such would be greatly appreciated.

It would have been obvious to modify the base systems as relied upon above in paragraph 4 with such well known multi-pulse, or single pulse strategy, motivation is to use existing pulse strategies and hence increase the operability of the base system to include already existing formats.

6. Claims 4,5,6, 7,8, 12,13,14,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraph 4 above, and further in view of Lim.

With respect to the above claims, such a format is in existence already – see figure 5 of Lim for instance.

With respect to claims 6 and 8, such is interpreted as the summed rf signal at the output of the optical detectors in either the base references, or the system used in Lim.

It would have been obvious to modify the base system in Ko with the above teachings from Lim, motivation is to permit the Ko systems to use well known formats of Lim, and hence increase Lim's recording marketability/desirability.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 12 as stated in paragraph 6 above, and further in view of Miyake et al.

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Miyake et al discloses the ability of having information identifying velocity – which the examiner interprets as recording speed.

It would have been obvious to modify the base systems as relied above with respect to claim 12 and include the additional speed parameter – motivation is to permit a transparent operation upon rec/repr.

8. Claims 18,19,20,21,22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the Ko references ('054), ('493) or ('605) as relied upon in paragraph 4 above, and further considered with Miyake et al.

The Ko references are relied upon for the reasons stated above with the analysis of claims 1 and 24, and 32 as stated in paragraph 4 above; note the title and the abstract. The examiner concludes that these systems depict a disc having the lead in, lead out and data areas. A product is either the direct result of the method, or the apparatus of the above Ko systems.

There is no writing pattern clearly depicted, although there is modulation information.

Miyake et al teaches in this environment the ability of having writing strategies, ws1, ws2 appropriately located for the desired ability. This is interpreted as meeting the limitations with respect to one of a multi-pulse and a single-pulse write strategy.

The sum signal is inherently present, i.e., the output of the optical detector elements.

9. Claims 24,25,26,27, 28,29, 30, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, (references ('054), ('493) or ('605) further considered with Tasaka et al (WO document) and all further considered with Miyake et al. The examiner is not providing a copy of the Tasaka et al WO document and instead is relying upon the US patent equivalent of such – patent 7068579 – as providing the English translation thereof.

The Ko references are relied upon for the reasons stated above with the analysis of claims 1 and 24, and 32 as stated in paragraph 4 above; note the title and the abstract. The examiner concludes that these systems depict a disc having the lead in, lead out and data areas.

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Tasaka et al is relied upon for the reasons stated above, i.e., see figure 3 with respect to the discussion of bp area, depicts reserved areas as well as the writing speeds, and the OPC capability.

In Miyake et al – see the discussion with respect to figure 62 and the various positions within the read only and read able areas.

The sum signal is inherently present, i.e., the output of the optical detector elements.

It would have been obvious to modify the base system of Ko with the above teachings from Tasaka et al and Miyake et al, motivation is to use existing disc having established formats thereon and hence save valuable resources such as designing new disc formats.

Errata

The subject matter of claim 3/1 and that of claim 18 are substantially duplicative of each other. Further clarification is respectfully required, else if claim and 3/1 is allowed, then the duplicate claims 18, and will be objected to and require cancellation, see MPEP § 706.03 (k).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-Thru: 6:00 - 3:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aristotelis M Psitos
Primary Examiner
Art Unit 2627

/Aristotelis M Psitos/
Primary Examiner, Art Unit 2627